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Filed : July 28, 2003

REMARKS

Claims 1-14 and 30 are now pending in the present application, Claim 1 having been amended and Claims 30-32 having been added. The claims set forth above include marking to show the changes made by way of the present amendment, deletions being in ~~strikeout~~ and additions being underlined.

The Applied Combination of Swab/McManigal Does Not Make Obvious Claims 1-4 or 30-32

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,769,767 issued to Swab, et al. in view of U.S. Patent No. 5,327,178 issued to McManigal. Applicants respectfully traverse the present rejection. However, in order to expedite prosecution of the present application, Applicants have amended Claim 1. Applicants also expressly reserve the right to further prosecute the original and previously presented versions of Claim 1 through continuation practice.

Swab teaches a wireless ad hoc pico network formed by eyewear and other devices. The eyewear includes a frame and connected to the frame are two temples. The temples may have co-molded within their bodies an apparatus, such as an audio device, a speaker, and a microphone. McManigal teaches a loudspeaker carried by a support structure, which includes a closed loop sleeve to be placed over the ear stem of eyeglasses. However, both Swab and McManigal fail to teach, inter alia, first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a *predetermined distance* about first and second predetermined pivot axes, as claimed.

Section 2143 of the M.P.E.P. states that to establish prima facie obviousness, the following three requirements must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

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be found in the prior art, and not based on the Applicant's disclosure.

Without commenting on the presence of a suggestion or motivation to combine the reference teachings, or the indication of a reasonable expectation of success, Applicants contend that the Examiner has failed to establish a prima facie case of obviousness at least because the prior art references when combined fail to teach or suggest all of the claim limitations.

The structure of the device of Claim 1 includes, inter alia, first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermined distance about first and second predetermined pivot axes. In contrast, the Swab and McManigal references fail to disclose a speaker mounted to a mounting mechanism that is configured to pivot a predetermined distance about a predetermined pivot axis.

For example, Swab teaches speakers co-molded within the body of an eyeglass temple, see Swab, column 5, lines 48-50, 59-63, a speaker mounted on each temple of eyewear, id. at column 6, lines 23-24, a speaker removably mounted on a temple, id. at column 6, lines 39-41, and a temple housing a removable speaker, id. at column 7, lines 9-11.

However, nowhere does Swab teach or suggest, inter alia, first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermined distance about first and second predetermined pivot axes, such as claimed.

Similarly, McManigal teaches a flexible lead 51 connecting a speaker assembly 50 to a personal stereo unit, car phone, or other audio sources. See McManigal, column 6, lines 30-32; see also id. at FIGS. 4 and 5. McManigal explains that “the sleeve deforms to grip the ear stem and conforms to it. The sleeve, although deformed and conforming, is still free to be manually rotated by the user.” Id. at column 8, lines 15-18. As the speaker-holding sleeves of McManigal are free to rotate about the eyeglass stems, McManigal does not disclose, inter alia, pivotability a predetermined distance about a pivot axis, as claimed. Therefore, even if the Swab reference could be combined with the McManigal reference, the combination still would fail to teach all the elements of Claim 1.

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Additionally, Applicants submit that Claims 2-4 and new Claims 30-32 also define over the combination of the Swab and McManigal references, not only because they depend from Claim 1, but also on their own merit. Therefore, Applicants respectfully request allowance of Claims 1-4 and 30-32.

The Applied Combination of Swab/McManigal/Vogt Does Not Make Obvious Claims 5-7

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swab in view of McManigal and further in view of U.S. Patent No. 5,606,743 to Vogt, et al. Applicants respectfully traverse the present rejection. As noted above, Applicants submit that Claim 1 clearly and non-obviously defines over the combination of the Swab and McManigal references. Thus, Applicants submit that Claims 5-7 also define over the prior art, not only because they depend from Claim 1, but also on their own merit.

The Applied Combination of Swab/McManigal Does Not Make Obvious Claims 8 and 11-14

Claims 8 and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,769,767 issued to Swab, et al. in view of U.S. Patent No. 5,327,178 issued to McManigal. Applicants respectfully traverse the present rejection.

Without commenting on the presence of a suggestion or motivation to combine the reference teachings, or the indication of a reasonable expectation of success, the Examiner has failed to establish a prima facie case of obviousness at least because the prior art references when combined fail to teach or suggest all of the claim limitations.

The structure of the device of Claim 8 includes, inter alia, a compressed audio file storage and playback device disposed in the first ear stem. In contrast, the Swab and McManigal references fail to disclose, inter alia, a compressed audio file storage and playback device disposed in an ear stem of an eyeglass.

The Applicants recognize that Swab describes a connected hinge “which permits electrical conduction between the both temples [sic] and the frame enables the sharing of functionality between the left and right temples. It further enables the battery and the circuitry such as the Bluetooth PCB to be on opposing sides to accommodate more circuitry and their functions and to balance the weight and volume.” See Swab, column 5, lines 29-35. However,

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Swab doesn't disclose, inter alia, a compressed audio file storage and playback device disposed in an ear stem of an eyeglass as claimed.

For example, Swab teaches that "eyewear 12 may be *connected to* various audio-playing devices, for example, an MP3 audio player 58, *through the eyewear transceiver 18* coupled to the MP3 player's transceiver 70, as shown in the flow-chart of FIG. 4. . . . Similarly . . . the MP3 player 58 is equipped with *its own transceiver 70* capable of exchanging signals with the transceiver 18. In operation, when MP3 player plays back previously stored music or any other stored audio signal, the transceiver 70 feeds this signal to the transceiver 18 which, in turn, *conveys the signal to the speakers 60 and 62.*" See Swab, column 6, lines 18-44 (emphasis added). It is clear that while Swab may contemplate eyewear communicating with an MP3 player through transceivers 18, 70, Swab does not teach or suggest a compressed audio file storage and playback device disposed in the earstem of eyeglasses, such as claimed in Claim 8.

Similarly, although McManigal teaches a flexible lead 51 connecting a speaker assembly 50 to a personal stereo unit, car phone, or other audio sources, see McManigal, column 6, lines 30-32; see also id. at FIGS. 4 and 5, McManigal fails to teach or suggest a compressed audio file storage and playback device disposed in the earstem of eyeglasses, as claimed, as well. Therefore, even if the Swab reference could be combined with the McManigal reference, the combination still would fail to teach all the elements of Claim 8.

Additionally, Applicants submit that Claims 11-14 also define over the combination of the Swab and McManigal references, not only because they depend from Claim 8, but also on their own merit. Therefore, Applicants respectfully request allowance of Claims 8 and 11-14.

The Applied Combination of Swab/McManigal/Vogt Does Not Make Obvious Claims 9 and 10

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swab in view of McManigal and further in view of Vogt. Applicants respectfully traverse the present rejection. As noted above, Applicants submit that Claim 8 clearly and non-obviously defines over the combination of the Swab and McManigal references. Thus, Applicants submit that Claims 9 and 10 also define over the prior art, not only because they depend from Claim 8 but also on their own merit.

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CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issues promptly.

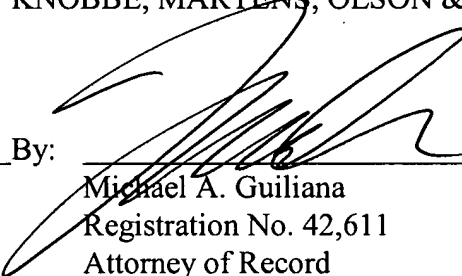
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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